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**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: **Charles Eric Hunter**      Confirmation No.: **7280**  
Serial No.: **09/476,078**      Group Art Unit: **3600**  
Filing Date: **December 30, 1999**      Examiner: **Calvin L. Hewitt II**  
For: **VIDEO AND MUSIC DISTRIBUTION SYSTEMS**

Mail Stop Appeal-Brief Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**APPELLANT'S BRIEF PURSUANT TO 37 C.F.R. § 41.37**

This brief is being filed in support of Appellant's appeal from the rejections of claims 1-25, 27, 31-33 dated June 22, 2007. A Notice of Appeal and Pre-Appeal Brief Request for Review were filed on December 13, 2007. A Notice of Panel Decision from Pre-Appeal Brief Review was mailed on February 7, 2008.

**I. REAL PARTY IN INTEREST**

Ochoa Optics LLC, an entity of Intellectual Ventures LLC, is the real party in interest in the present application

## **II. RELATED APPEALS AND INTERFERENCES**

An appeal is pending in the related case Application No. 09/707,273.

A Notice of Appeal accompanied by a Pre-appeal Request for Review was filed in the related cases below:

09/645,087

09/684,442

11/085,944

**III. STATUS OF CLAIMS**

**A.** Claims 1-25, 27, and 31-33 are pending in this present application. There are five independent claims: 1, 10, 27, 31, and 32.

**B.** No claims have been deemed allowable.

**C.** Claims 26 and 28-30 have been cancelled.

**D.** Claims 1 – 25, 27 and 31 – 33 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,572,442 to Schulhof et al. (“Schulhof”) in view of U.S. Patent No. 6,272,636 to Neville et al. (“Neville”).

**IV. STATUS OF AMENDMENTS**

No amendments to pending claims have been filed subsequent to the final rejection dated June 22, 2007.

**V. SUMMARY OF CLAIMED SUBJECT MATTER**

The claims relate generally to methods, devices, and systems for distributing music. In an example embodiment, digital music is transmitted to customer stations. Customers may preselect music content items for recording in local storage. Customers may be allowed to play recorded music items up to a predetermined number of times without charge. Customers may select music items for unrestricted playback rights. Alternatively, a request for unrestricted playback rights may be generated automatically when the customer plays the music item a predetermined number of times. The request is received by a distribution system which then grants the unrestricted playback rights and bills the customer for those rights.

The table below summarizes the subject matter of the independent claims. Support for the claim recitations is found at least at the cited references in the specification.

| Claim | Summary   | Specification Pages, Line Numbers, and Drawings  |
|-------|---|--|
| 1     | In exemplary aspects, information indicating a request for unrestricted playback rights is automatically generated when a music content, previously recorded at a customer's station, has been played at least some predetermined number of times is received, permission for unrestricted playback is granted, and the customer is billed.   | Specification page 33, lines 11-19; page 34, line 11 – page 35, line 2; page 37, line 3 – page 39, line 2.   |
| 10    | In exemplary aspects, a device comprises a mechanism by which a user can preselect music items for recording, a mechanism by which music items can be received and recorded; a mechanism by which a recorded music content can be selected for unrestricted playback rights; and a mechanism for generating a request for unrestricted playback rights automatically when a music item has been played at least some predetermined number of times and for communicating the request. | Specification page 12, line 22 – page 13, line 2; page 18, lines 1-24; page p. 19, lines 10-25; page 20, line 3 – page 21, line 13; page 33, lines 11-19; page 34, line 11 – page 35, line 2; page 37, line 3 – page 39, line 2. |

|    |   |   |
|----|---|---|
| 27 | <p>In exemplary aspects, a system comprises a computer-based device capable of recording, storing, and playing back music selections. The device comprises an interface enabling a consumer to preselect music items for recording, a recorder; an interface enabling the selection of previously recorded music for unrestricted playback rights; and a module communicating requests for unrestricted playback rights where the request is generated automatically when a recorded music selection is played at least some predetermined number of times.</p> | <p>Specification page 12, line 22 – page 13, line 2; page 18, lines 1-24; page p. 19, lines 10-25; page 20, line 3 – page 21, line 13; page 33, lines 11-19; page 34, line 11 – page 35, line 2; page 37, line 3 – page 39, line 2.</p> |
| 31 | <p>In exemplary aspects, a device comprises a first interface that enables a user to select a previously recorded music content item for unrestricted playback rights and a second interface that communicates a request for unrestricted playback rights that is automatically generated when a recorded music item has been played at least some predetermined number of times.</p>   | <p>Specification page 33, lines 11-19; page 34, line 11 – page 35, line 2; page 37, line 3 – page 39, line 2.</p>   |

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|----|--|--|
| 32 | <p>In exemplary aspects, information regarding a music item available for recording is provided to a consumer, consumer preselection of the music item is facilitated, the music item is transmitted to a station, a request for unrestricted playback rights for the music item is automatically generated when the music item has been played some predetermined number of times and the request is received, and an enabling code for unrestricted playback of the music item is transmitted.</p> | <p>Specification page 12, line13 – page 13, line 19; page 20, line 3 – page 21, line 13; page 26, line 19 – page 27, line 17; page 33, lines 11-19; page 34, line 11 – page 35, line 2; page 37, line 3 – page 39, line 2.</p> |
|----|--|--|



**VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The rejection of claims 1 – 25, 27 and 31 – 33 under 35 U.S.C. § 103(a) as allegedly unpatentable over Schulhof et al. U.S. Patent No. 5,572,442 (“Schulhof”) in view of Neville et al. U.S. Patent No. 6,272,636 (“Neville”).

## VII. ARGUMENT

Appellant respectfully traverses the Examiner's rejection of claims 1 – 25, 27 and 31 – 33 under 35 U.S.C. § 103(a) as allegedly unpatentable over Schulhof et al. U.S. Patent No. 5,572,442 ("Schulhof") in view of Neville et al. U.S. Patent No. 6,272,636 ("Neville").

### Claim 1

Claim 1 is rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Schulhof in view of Neville. Appellants respectfully submit that Schulhof and Neville, alone or in combination, do not disclose or suggest the subject matter of claim 1. In particular, at least the following recitation from claim 1 is not taught by the cited references:

receiving unrestricted playback selection information regarding  
a previously recorded music content item from a station, said  
station being associated with a customer, said unrestricted  
playback selection information having been generated  
automatically upon determining that the previously recorded  
music content item has been played at least a predetermined  
number of times at the station;

As an example of an embodiment implementing the claimed method, a user will have access to a previously recorded music content item and be allowed to listen to the recorded music some number of times, possibly without being billed for the music content item. Upon the music content item being played some predetermined number of times, say for purposes of this discussion  $n$  times, information indicating a selection of the music content item for unrestricted playback rights is automatically generated and is received by a system operator that then grants the unrestricted playback rights. The customer need do no more than play the music content item  $n$  times. The customer is not prohibited from playing the music content item the  $n^{\text{th}}$  time and no dialog box is presented to the customer to inquire whether the customer wishes to select the music content item for unrestricted playback rights.

In the Response to Amendments/Arguments section, the Examiner stated that "automation of a known process that accomplishes the same result as the known process is not patentable." (Office Action dated 6/22/07, at p. 2-3). Applicants disagree with the characterization of the claimed process. Applicants submit that the process described in

claim 1 is not a “mere automation of a known process.” Rather, the process described in claim 1 is materially different from that described by Neville. For example, Neville discloses:

If the trial evaluation is complete, the control passes to block 610 where meter code section 402 **presents a message to the user indicating the trial evaluation has terminated** and that **purchase is now required** to continue use. Code section 402 then terminates and control returns to block 600 for normal operating system control, i.e., as before the user initiated execution of product 200. (Neville, column 9, lines 46-53, emphasis added.)

If the user is not to be allowed use of this application, i.e., the **server/clearinghouse 804 determines that an evaluation period has expired**, the **server does not transmit the unlock key 803** to the end-user 806 computing device **but sends and “end of evaluation” message**. (Neville, column 13, lines 31-35, emphasis added.)

If, however, the user’s evaluation use has expired, then processing branches from decision block 904 to block 908 where **an expiration message may be delivered from clearinghouse 804** to the end-user 806 computing device indicating that **execution is not allowed** and that the evaluation use has expired. (Neville, column 14, lines 9-15, emphasis added.)

According to the method of claim 1, the selection for unrestricted playback is generated automatically, *without a need for a customer decision or interaction*, upon determining that the music content item has been played at least some predetermined number of times. Neville describes a clearinghouse that sends an expiration message to the end user after the evaluation period expires. The expiration message is displayed on a user interface of the user’s terminal and the *user must then decide and select* whether they wish to purchase the full version. Applicants submit that claim 1 is not merely automating a known process, but is rather a materially different process whereupon playing a music content item some predetermined number of times triggers the automatic generation of a selection of the item for unrestricted playback without offering the user a choice not to select the item for unrestricted playback or requiring the user to make a decision.

Schulhof’s specification describes a subscriber selecting program material for playback as desired (Schulhof, column 4, line 48 to column 5, line 20; column 6, lines 24-52), a subscriber selecting materials on a one-time basis or a subscription basis (Schulhof, column 7, line 54 to column 8, line 2), a subscriber purchasing trial subscriptions in which portions of materials are periodically deleted (Schulhof, column 9, lines 20-26), and an

information request manager that manages subscriber program requests (Schulhof, column 10, lines 42-65). In no case does Schulhof describe *automatically* generating unrestricted playback selection information in response to a determination that an item has been played *at least a predetermined number of times*.

Applicants contend that automatically generating a request for unrestricted playback rights in response to determining a music content item has been played a predetermined number of times is not the “mere automation of a known process that accomplishes the same result as the known process,” such as asserted by the Examiner. (Office Action of 6/22/07, pp. 2-3.) For example, in an embodiment of the claimed method, a customer plays a music item an  $n^{\text{th}}$  time, triggering an automatically generated request for unrestricted playback rights which are then granted and the customer is billed. In the teachings of Neville, a customer attempts to play a music item an  $n^{\text{th}}$  time, triggering an expiration message informing the customer that a trial period is over and purchase is required. The customer must then make a decision and take an affirmative act to purchase unlimited usage rights. As the Examiner noted, Schulhof does not teach customers selecting previously recorded music selections for unrestricted playback. (Office Action of 6/22/07, p. 6.) The Examiner does not assert in the Office Action that the any of the cited art teaches “unrestricted playback information having been generated automatically upon determining that the previously recorded music content item has been played at least a predetermined number of times at the station.”

Moreover, claim 1 recites “unrestricted playback selection information having been generated automatically upon determining that the *previously recorded music content item has been played* at least a predetermined number of times at the station.” (Claim 1, emphasis added.) Schulhof states: “when a subscriber has *completed placing the order*, a payment icon is displayed that requires the subscriber to authorize billing to his account” (Schulhof, col. 7, ll. 61-63, emphasis added) and “[o]nce the order process is completed, high speed data transfer may begin, or data transfer may be delayed until a time when the cable television line is not being used to supply television programming” (Schulhof, col. 8, ll. 5-8). That is, Schulhof teaches that an order process is completed before the content is transmitted to the user’s location. Thus, according to Schulhof any selection of a music content for unrestricted playback rights is made before a user ever receives a music content item, and thus certainly before it has been played at least a predetermined number of times at the user’s station.

For at least the reasons explained above, Applicants respectfully submit that the Schulhof and Neville, either alone or in combination, do not teach the quoted claim recitations and, therefore, claim 1 is patentably defined over the cited art.

**Claims 10, 27, 31 and 32**

Claim 10 recites in part:

a mechanism configured to communicate unrestricted playback selection information regarding a previously recorded music content item, which was previously recorded in the storage medium, said unrestricted playback selection information having been generated automatically upon determining that the previously recorded music content item has been played at least a predetermined number of times.

Claim 27 recites in part:

a communications module configured to communicate unrestricted playback selection information from the station, said unrestricted playback selection information having been generated automatically upon determining that a previously recorded music content item has been played at least a predetermined number of times at the station.

Claim 31 recites in part:

a second interface configured to communicate unrestricted playback selection information from the station and for receiving enabling information for enabling unrestricted playback of a previously recorded music content item, said unrestricted playback information being automatically generated and communicated upon determining the previously recorded music selection has been played at least a predetermined number of times at the station.

Claim 32 recites in part:

receiving a request for unrestricted playback rights for the music content item, said request having been generated automatically upon determining that the music content item has been played at least a predetermined number of times at the station;

The remarks presented above with respect to the quoted recitation from claim 1 apply as well to the quoted recitations from claims 10, 27, 31 and 32. Thus, for at least this reasons presented above with respect to claim 1, Applicants respectfully submit that claims 10, 27, 31, and 32 are patentably defined over the cited art.

**Claims 2-9, 11-25, and 33**

Claims 2–9 and 24 depend, directly or indirectly, from claim 1. Claims 11–23 and 25 depend, directly or indirectly, from claim 10. Claim 33 depends from claim 32. Applicants respectfully submit that for at least the reasons explained above with respect to independent claims 1, 10, and 32, dependent claims 2-9, 11-25, and 33 are patentably defined over the cited art.

**VIII. CLAIMS APPENDIX**

The following claims are under appeal:

1. A method comprising:

receiving unrestricted playback selection information regarding a previously recorded music content item from a station, said station being associated with a customer, said unrestricted playback selection information having been generated automatically upon determining that the previously recorded music content item has been played at least a predetermined number of times at the station;

granting permission for unrestricted playback of the previously recorded music content item; and

billing the at least one customer based on the unrestricted playback selection information received.

2. The method as claimed in Claim 1, further comprising transmitting digital music content at data transmission rates faster than real time.

3. The method as claimed in Claim 1, further comprising providing associated information including music content availability, scheduling and content pricing data.

4. The method as claimed in Claim 3, further comprising providing an interactive program guide via a display device configured to enable selection of available digital music content items and selection of functions for recording said music content items and functions for playing back recorded music content items.

5. The method as claimed in Claim 4, further comprising: receiving and decoding a music content item and associated information and storing the decoded music content item and associated information in a digital data storage device.

6. The method as claimed in Claim 5, further comprising providing remote access to said decoded content availability, scheduling and content pricing data, said remote access including a direct Internet access link to a website of the content provider or via phone line connection.

7. The method as claimed in Claim 6, further comprising enabling the playing of a decoded and stored music content item a limited number of times on a no-charge basis.

8. The method as claimed in Claim 7, further comprising generating a permanent enabling code for inclusion with said recorded music content items selected for unrestricted playback to thereby enable unrestricted playback.

9. The method as claimed in Claim 1, further comprising transmitting digital music content to the at least one station via a direct broadcast satellite (DBS) system, said transmitting comprising: scheduling and transmitting encoded music content to a direct broadcast satellite up-link facility via a central controller and transmitting program/pricing information to said up-link facility on a periodic basis.

10. A device comprising:  
a mechanism configured to enable preselection of music content items for recording;  
a mechanism configured to receive at least one music content item and configured to record the received at least one music content item in a storage medium in response to the preselection;  
a mechanism configured to enable selection of a previously recorded music content item, which was previously recorded in the storage medium, for unrestricted playback; and  
a mechanism configured to communicate unrestricted playback selection information regarding a previously recorded music content item, which was previously recorded in the storage medium, said unrestricted playback selection information having been generated automatically upon determining that the previously recorded music content item has been played at least a predetermined number of times.

11. The device as claimed in Claim 10, wherein said mechanism configured to receive at least one music content item is configured to receive the at least one music content item via a direct broadcast satellite (DBS) system.

12. The device as claimed in Claim 11, wherein said mechanism configured to receive at least one music content item is configured to receive the at least one music content item at a data rate faster than real time.

13. The device as claimed in Claim 11, further comprising:



a mechanism configured to receive music content availability, scheduling and content pricing data.

14. The device as claimed in Claim 13, wherein said mechanism configured to enable preselection of desired music content items for recording comprises an interactive program guide mechanism configured to enable selection of available digital music content items and to enable selection of functions for recording said music content items and functions for playing back recorded music content items.

15. The device as claimed in Claim 13, further comprising a decoder device configured to receive and decode music content items and associated information and store decoded music content items and associated information in a digital data storage device.

16. The device as claimed in Claim 13, further comprising a mechanism configured to enable remote access to said content availability, scheduling and content pricing data, said remote access is via a direct Internet access link to a website of a content provider or via phone line connection.

17. The device as claimed in Claim 14, wherein said storage medium includes one selected from the group consisting of: read/write CD's, write only CD's, DVD RAM, magneto-optical disc, and digital tape.

18. The device as claimed in Claim 15, further comprising a mechanism configured to enable playing a decoded and stored music content item one or more times on a no-charge basis.

19. The device as claimed in Claim 18, further comprising a mechanism configured to receive a permanent enabling code that is received subsequent to the recording of a music content item, said permanent enabling code configured to cooperate with said recorded music content item selected for unrestricted playback to thereby enable said unrestricted playback.

20. The device as claimed in Claim 16, further comprising a mechanism configured to receive music content from a direct broadcast satellite up-link facility, and receive program/pricing information transmitted to said up-link facility on a periodic basis.

21. The device as claimed in Claim 11, wherein said direct broadcast satellite system operates in the KU Band or other suitable frequency bands.

22. The device as claimed in Claim 11, wherein said storage medium comprises a multiple disc platter for storing multiple disks each comprising recorded stored multimedia content.

23. The device as claimed in Claim 11, further comprising digital content/programming transmission links including one or more selected from the group consisting of: cable, optical fiber, DSL and Internet connections.

24. The method of Claim 1, wherein the previously recorded music content item is recorded on DVD RAM.

25. The device of Claim 10, wherein the mechanism configured to record comprises DVD RAM.

27. A system comprising:  
a computer-based recording, storage and playback station, said station comprising:  
a first interface configured to enable preselection, from received availability information, available music content items for recording;  
a recording module configured to record received music content items in a storage medium;  
a second interface configured to enable selection of previously recorded music content items which were previously recorded in the storage medium for unrestricted playback; and  
a communications module configured to communicate unrestricted playback selection information from the station, said unrestricted playback selection information having been generated automatically upon determining that a previously recorded music content item has been played at least a predetermined number of times at the station.

31. A station for enabling unrestricted playback of a previously recorded music selection comprising:

a first interface configured to enable selection for unrestricted playback a previously recorded music content item which was previously recorded in a storage medium;

a second interface configured to communicate unrestricted playback selection information from the station and for receiving enabling information for enabling unrestricted playback of a previously recorded music content item, said unrestricted playback selection information being automatically generated and communicated upon determining the previously recorded music content item has been played at least a predetermined number of times at the station.

32. A method of distributing a music content item, the method comprising:

providing information identifying a music content item available for recording;

enabling preselection of the music content item for recording at a station;

transmitting the music content item to the station;

receiving a request for unrestricted playback rights for the music content item, said request having been generated automatically upon determining that the music content item has been played at least a predetermined number of times at the station; and

transmitting, in response to the received request, a code configured to enable unrestricted playback of the music content item.

33. A method as in claim 32, wherein transmitting the music content item comprises transmitting digital music content via a direct broadcast satellite system.

**IX. EVIDENCE APPENDIX**

None

**X. RELATED PROCEEDINGS APPENDIX**

None

***Conclusion***

Appellants submit that claims 1-25, 27, and 31-33 patentably define over Schulhof in view of Neville.

Applicants respectfully request that the Board reverse the rejections of claims 1-25, 27, and 31-33.

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/Kenneth E. Plochinski/  
Kenneth E. Plochinski  
Registration No. 59,166

Woodcock Washburn LLP  
Cira Centre  
2929 Arch Street, 12th Floor  
Philadelphia, PA 19104-2891  
Telephone: (215) 568-3100  
Facsimile: (215) 568-3439